

PATENT  
Attorney Docket No. 5804.02  
Express Mail Label No. EL 779730586 US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

David Z. LUBOWSKI

Appl. No.: 09/363,773

Filed: July 29, 1999

For: SIGMOIDOSCOPE

Examiner: J. RAM

Art Unit: 3739

**PRELIMINARY AMENDMENT**

Box PATENT APPLICATION  
Commissioner for Patents  
Washington, D.C. 20231

Sir:

This preliminary amendment is submitted contemporaneously with the continuation application filed in the above case on 8 February 2002.

**REMARKS**

This Preliminary Amendment is submitted contemporaneously with the continuation application filed in the above referenced case. Claims 1-40 are included in the continuation application.

Claims 1-40 are similar to claims 1-50 of the parent application, which shares the specification with this application. For example, claim 1 of the present application recites the limitations of claims 1, 3, and 22 of the parent application. Therefore, Applicant respectfully submits that claims 1-40 are fully supported by the specification and add no new matter. Applicant further respectfully provides the following remarks regarding patentability of the pending claims.

In the parent application, independent claim 1 and claim 22 (similar to claim 1 of the continuation application) were rejected by the Examiner in his 19 June 2001 final Office action as anticipated by United States Patent No. 4,852,551 to Opie et. al. (*Opie*). In an effort to avoid similar rejections in the continuation application, the applicant offers the following comments regarding the rejections in the parent.

Initially, Applicant notes that claim 1 requires the sigmoidoscope to include a "disposable speculum." Claim 22 of the parent application recited a similar requirement. Claim 1 of the present application, therefore, combines features of both claims 1 and 22 of the parent application as well as additional patentable features not discussed herein.

With respect to claims 1 and 22, Applicant respectfully suggests that the Examiner has misinterpreted *Opie*. Specifically, the Examiner alleges that *Opie* teaches "a disposable speculum including an insertion end (12) an interior (14) and an observation end 16); [and] a disposal window at the observation end (30)." The cited reference numerals refer to various elements in *Opie*. Applicant respectfully submits that none of these elements are disposable. Further, Applicant asserts that *Opie* specifically teaches that **none** of these parts are disposable.

*Opie* discloses "an endoscope and valve system specially adapted for use with a disposable sheath" (Abstract, lines 1-2). The endoscope "includes a tip portion 12, [and] a flexible insertion tube 14" which are "adapted for use with a disposable sheath 18" (col. 6, lines 7-15). The insertion tube 14 additionally "contains control cables (not shown) extending between the control handle 16 and tip portion 12" (col. 6, lines 30-32). These cables permit an operation to flex the tip portion 12 (col. 6, lines 64-65). The disposable sheath generally fits over the insertion tube and tip (Fig. 1), and includes a number of tubes 46, namely a suction tube 46a, an air tube 46b, and a water tube 46c (col. 7, lines 61-63; col. 9, lines 24-25; col. 9, lines 5-7).

When an examination concludes, the sheath and portions of associated tubes 46a-c are discarded and may be replaced before a subsequent examination(col. 10, lines 28-52). The insertion tube, however, is **not** discarded. Indeed, the entire point to the disposable sheath 18 is to ensure that the expensive insertion tube 14 may be reused (see, generally, cols. 1-4). By specifically stating that only the disposable sheath 18 and associated tubes 46 are discarded, *Opie* indicates that all other pieces are reused. This includes those elements cited by the Examiner as anticipating the disposable speculum required by independent claim 1. Accordingly, Applicant respectfully submits that *Opie* in fact teaches a non-disposable speculum, rather than the disposable speculum recited by claim 1.

The Examiner briefly mentioned in his Response to Applicant's Arguments that, "since anything can be disposed of, the examiner considers everything to be 'disposable.'" Applicant respectfully submits that the Examiner has interpreted the word "disposable" too broadly. First, Applicant asserts that "disposable" has a specific meaning within the context of independent claim 1. By including a reference to a "reusable part," claim 1 inherently limits "disposable" to only a portion of the invention. Further, *Opie* contains nondisposable parts such as the control handle 16 and associated electronics. Again, *Opie* specifically differentiates between the disposable sheath 18, which is discarded, and the rest of the endoscope, which is retained. Although anything may theoretically be disposed of, the Examiner's reading of the word is contrary to the teachings of both the cited reference and the present application. Following the Examiner's reasoning, such items as houses and automobiles are also "disposable," no matter how expensive or permanent the items may be.

Further, a cursory examination of the structure of *Opie*'s endoscope indicates that the insertion tube 14 may not be discarded without also disposing of the entire scope. The tip 12 of the insertion tube 14 is connected to the handle 16 via control cables running the length of the tube 14. *Opie* contains no teaching or suggestion that the

insertion tube 14 is removably connected to the handle 16. Rather, the presence of the control cables indicates that the connection is permanent. Thus, in order to dispose of the insertion tube, one must also throw away the control handle and all associated valves, controls, and so forth. This effectively results in disposal of the entire instrument. Not only is this completely contrary to *Opie*'s teachings, such an interpretation indicates that *Opie*'s invention contains no *reusable* part. Thus, the mechanism of *Opie* (with the exception of the removable sheath) is either entirely disposable or entirely reusable, but not both. By contrast, independent claim 1 requires both a "reusable part" and a "disposable speculum." Applicant therefore respectfully submits that the Examiner's interpretation of *Opie*'s insertion tube 14, tip 12, and window 30 cannot anticipate claim 1.

Applicant respectfully asserts he has shown that *Opie* fails to teach a "disposable speculum" as required by independent claim 1. Therefore, Applicant respectfully submits that claim 1 is patentable in light of the cited reference. Insofar as claims 2-40 depend from independent claim 1, Applicant further submits that these claims are also patentable. Applicant makes this argument with no reference to and without negating the independent bases of patentability contained within each of these dependent claims. Applicant accordingly states that claims 1-40 are in condition for allowance, and respectfully requests the issuance of a Notice of Allowance as soon as practicable.

### **CONCLUSION**

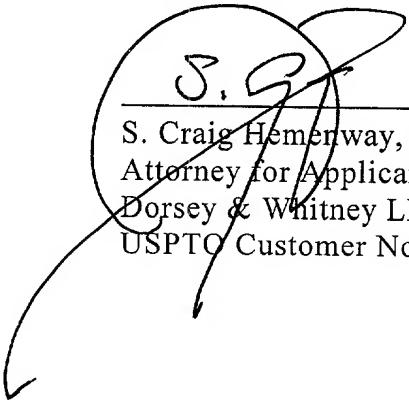
Applicant believes that no new matter has been added by this Preliminary Amendment. It is respectfully requested that this Preliminary Amendment be entered.

It is believed that the proper fee associated with this Preliminary Amendment has been submitted herewith. Any fee deficiency may be charged to Deposit Account 04-

1415. Any questions regarding this Preliminary Amendment can be directed to the undersigned attorney.

Dated this 8<sup>TH</sup> day of FEBRUARY.

Respectfully submitted,



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